

### **Remarks/Arguments**

Claims 1 to 4 are pending. Claims 1 to 3 have been amended to place them more in U.S. form and practice. Support for new dependent Claim 4 is found on page 4, lines 3 to 5 – it is established herein that independent Claim 1 is not obvious over the (two reference) combination obviousness rejection so dependent Claim 4 is also not obvious.

The Office Action stated: that the listing of references in the specification is not a proper information disclosure statement; that 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office; MPEP § 609.04(a) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.”; and that, therefore, unless the references have been cited by the Examiner on form PTO-892, they have not been considered. Applicants disagree with this statement. The Examiner is required to read and consider all of the disclosure in the application, including the prior art disclosed and discussed in the application. Section 103(a) requires that all of the prior art of record be considered in the resolution of the level of ordinary skill in the pertinent art.

Under the heading Background Art, a detailed description of certain prior art is set out on page 1, lines 8 and 9, and page 1, line 12, to page 2, line 18, of the application – it is disclosure that the Examiner has to read and consider like all of the rest of the disclosure in the application.

Applicants have concurrently filed an art statement (IDS) and a list of the references submitted in such art statement and reference list – such references

are the Japanese patent document listed on page one of the specification and a US patent equivalent thereof.

The Office Action stated that the following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in the Office Action:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0130139 (Shiraishi et al.) in view of U.S. Patent No. 5,497,910 (Meadows et al.). Applicants traverse this rejection.

Applicants request that that the Examiner comply with the mandatory requirements of the Supreme Court's Graham and KSR decisions and Patent Office policy, and the pertinent CAFC decisions regarding Section 103(a).

A very important feature of the claimed invention of this application is the relationship between the expanding memory of the inner layer and the filtration resistance of the filter. The combination of the two rejection references does not result in applicants' claimed invention. Shiraishi et al. does not disclose that its

inner layer has expanding memory. All of the disclosure of the rejection references (and other prior art of record) has to be considered under Section 103(a). Section 103(a) requires facts, not speculation and hindsight. The Examiner has not carried his burden of proof.

The Office Action stated that the following is in reference to Claim 1:

The Office Action stated that Shiraishi et al. teaches:

A discharging container with a filter (1) comprising:

a bottle (2) which is formed in a manner wherein an inner layer (22) peelable from an outer layer (21) is formed on an inner surface of the outer layer;

a plug body (3) placed on a mouth portion (2a) of the bottle; and

a filter provided (7) in a discharging pass (10) which is provided in the plug body for discharging liquid kept in a body of the inner layer provided.

The Office Action further states that Shiraishi et al. further teaches:

~~wherein~~ a dispensing valve (8) has a memory which expands the valve in a manner wherein a difference between an inner negative pressure and an ambient air is higher than a filtration resistance of the filter (see page 6, [0075] last 7 lines); and

~~wherein~~ the negative pressure is caused by the memory of the valve (8) and by that liquid remained in a second side of the filter is sucked into a primary side of the filter (see [0043] and [0053]).

Shiraishi et al. does not teach or suggested applicants' claimed invention to one ordinarily skilled in the art.

The Office Action stated that Shiraishi et al. differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into a primary side of the filter rather than the memory of inner layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]). This statement is incorrect and incomplete. Nowhere apparently does Shiraishi et al. disclose or suggest the (claimed) expanding memory feature of the inner layer. Shiraishi et al. does not teach or suggest applicants' claimed invention to one ordinarily skilled in the art. Meadows does et al. not cure the defects of Shiraishi et al. in the quest for applicants' claimed invention.

The Examiner has not shown factually and/or legally that one ordinarily skilled in the art would, or even try to, combine Shiraishi et al. and Meadows et al. in the search for applicants' claimed invention. The Examiner has not carried his burden of proof.

The Office Action stated that Meadows et al. teaches:

In Figs. 1-3 of a dispenser similar to that of applicants' and Shiraishi et al. to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57 to 62, and col. 5, lines 35 to 43).

The Office Action stated that it would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of

using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows et al. in the dispenser of Shiraishi et al. because doing so would allow the suck back function to be performed without the use of a resilient valve. Applicants traverse this statement. The Examiner has not factually resolved the level of ordinary skill in the art so the Examiner has no basis in the record for asserting/stating what would be obvious to one ordinarily skilled in the art. Without such resolution of the level of ordinary skill in the art, this Section 103(a) is defective and fails a priori.

The Office Action stated, further, the application of the teaching of Meadows et al. to Shiraishi et al. constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S.\_\_\_\_, 82 USPQ2d 1385. Applicants traverse this statement. The Supreme Court in its KSR decision required that a three prong factual inquiry first be established in the record before any obviousness holding (rejection) could be made. One of the three mandatory factual inquiries that had to be made was the factual resolution in the record of the level of ordinary skill in the art – such mandatory resolution is missing in the case at bar. A holding of obviousness cannot be made until such foundation has been made in the record. Such mandatory foundation is missing from this case, hence the secondary considerations are not available. The Examiner has not factually established in the record that “predictable results” are yielded by combining the

two rejection references, or that the two rejection references are combinable in the manner attempted by the Examiner. It appears that this rejection is based on forbidden hindsight. The Examiner still has the burden of proof to prove in the record his various factual assertions.

It is clear that Claim 1 has not been proven to be obvious over the two rejection references, singularly or in combination.

The Office Action stated that applicant's arguments filed July 2, 2009 have been fully considered but they are not persuasive.

The Office Action stated that in response to the Examiner's notification in paragraph 1 that the listing of references in the specification is not a proper information disclosure statement, applicant argues that the Examiner is required to read and consider all of the disclosure in the application, including the prior art disclosed and discussed in the application; that the disclosure has been considered including applicant's description of the background art; however, considering applicant's description of a reference is not equivalent to considering the reference itself; that, consequently references which were not indicated as being considered in the Notice of References Cited or the Information Disclosure Statement have not been considered. Since, Section 103(a) in the basis of the present rejection, the Examiner's position is in error. Also, the Examiner has nowhere in the record refuted that the information such Background portion is in error or does not show that the claimed invention is unobvious to one ordinarily skilled in the art. The Examiner has not fulfilled his burden of proof under Section 103(a).

Page 4 of Applicant's Remarks/Arguments states:

A very important feature of the claimed invention of this application is the relationship between the expanding memory of the inner layer and the filtration resistance of the filter. The combination of the two rejection references does not result in applicants' claimed invention. Shiraishi et al. does not disclose that its inner layer has expanding memory. Meadows et al. does not disclose use of a filter. All of the disclosure of the rejection references (and other prior art of record) has to be considered under Section 103(a). Since Meadows et al. does not use a filter, the combination of Shiraishi et al. and Meadows et al. would not use a filter. [The Examiner has no basis of fact and/or law in the record to assert that the lack of a filter in Meadows et al. would have to give way to the use of a filter by Shiraishi et al. – to contend otherwise is mere hindsight and speculation by the Examiner. The Examiner has no basis (in the record) under 103(a) to choose one combination over the other. Section 103(a) requires facts, not speculation and hindsight.]

The Office Action stated: that these arguments are not found persuasive for several reasons; that, first, these arguments amount to a piecemeal analysis of the references; that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references; see *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); that, second, the obviousness rejection is being mischaracterized, the rejection is based on Shiraishi et al. as

modified by the teachings of Meadows et al., not vice versa as argued; and that, third, the reason for the modification as set forth in the rejection is based upon the teachings of Meadows et al. Applicants traverse this statement as being in error. Applicants treated the attempted combination of the two rejection references and showed that the attempted combination directed away from applicants' claimed invention. The Examiner has no basis in law to assert that one ordinarily skilled in the art would ignore the reverse insertion basis in the combination and the negative result thereof that directs away from the claimed invention. The Examiner has no basis under Section 103(a) to ignore that which destroys the obviousness rejection.

The Office Action stated that in the paragraph spanning pages 5 to 6, applicants argue that Shiraishi et al. fails to suggest the expanding memory feature of the inner layer; that this statement is factually incorrect; that Shiraishi et al. clearly indicates the bag/inner layer (22) is made of a synthetic resin made of a resilient material (see [0057] and [0060]) which as described has a "memory"; that Meadows et al. provides the further teaching to provide such a bag/inner layer with sufficient resilience to result in a suck back effect. This statement is in error. Nowhere in [57] and [60] does Shiraishi et al. recite the term "memory". Shiraishi et al. does not appear to disclose or suggest the memory and its actions and results as specified in applicants' claimed invention.

The Office Action stated that on pages 6 to 7, the applicant argues that "The Examiner has not factually resolved the level of ordinary skill in the art so the Examiner has no basis in the record for asserting/stating what would be



obvious to one ordinarily skilled in the art."; that, although it is not clear what precisely is meant by this statement as applied to the rejection of record, as best understood it appears to be based on a misconception of the requirement for deterring the level of ordinary skill in the art; that applicants' attention is directed to MPEP 2121.03 which states:

The "hypothetical" person having ordinary skill in the art to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App; & Inter. 1988) (The Board disagreed with the examiner's definition of one of ordinary skill in the art (a doctorate level engineer or scientist working at least 40 hours per week in semiconductor research or development), finding that the hypothetical person is not definable by way of credentials, and that the evidence in the application did not support the conclusion that such a person would require a doctorate or equivalent knowledge in science or engineering.); and

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

This statement is in error. The MPEP does not have the effect of the law or the rules. The portion of the MPEP quoted by the Examiner is not a correct statement of the law. The CAFC has said the prior art of record (if no other evidence is present) reflects the level of ordinary skill in the art – the CAFC did not say that the Examiner/judge/jury did not then have to resolve the level of ordinary skill in the art using the prior art of record as the factual basis for such mandatory resolution. The Supreme Court's Graham and KSR decisions, and Patent Office policy regarding such decisions, require resolution of the factual inquiry of the level of ordinary skill in the art before an Examiner can make a valid obviousness rejection. Therefore, the present obviousness rejection is flawed and its correction is requested.

The Office Action stated: that, in the rejection of record, the prior art itself is directed to the same field of endeavor (dispensing containers) – this not the required resolution. The Office Action stated that it clearly indicates that one having ordinary skill in this art understands that a container can be configured to provide a suck-back feature through a dispensing outlet and a dispensing outlet having a filter. The logic of this statement is faulty. How can the Examiner say what one having ordinary skill in the art understands when the Examiner has not yet resolved what is the level of ordinary skill in the art? The Office Action stated that the resilience of an inner container may be used to create this suck-back effect. This is still not the mandatory resolution under discussion. The Office Action stated the, in view of the above, it is unclear how the rejection could be construed as being deficient in ascertaining the ordinary level of skill in the art.

Nowhere has the Examiner set out in the record the resolution of the level of ordinary skill in the art and its supporting facts. Where is the analysis of the prior art of record, not just the rejection references, for such mandatory factual resolution? The Examiner has not carried his burden of proof.

The Office Action stated: that it is further argued that rejection fails to factually establish "predictable results" when applying the teaching of Meadows et al. to Shiraishi et al. and the rejection therefor is based on forbidden hindsight; that, as with the previous argument, it is not clear what precisely is meant by this statement as applied to the rejection of record; that the teachings of Meadows et al. in using the resilience of the inner container to obtain the suck back effect are clear; that, similarly, the fact that Shiraishi et al. includes a resilient inner container but discloses the valve as being used to obtain the desired suck back is also clear; asks what exactly is unpredictable about applying the Meadows et al. teaching of using the inner bag to assist or obtain the desired suck back in Shiraishi et al. is unclear. If the Examiner believes that applying a piece of technology from one reference of record into the technology of another reference of record will provide "predictable results", then applicants request that the Examiner submit his own declaration regarding, in detail, to support his assertion. Applicants have the right to study such declaration and then to accept it or to oppose it by supplying counter evidence and the like.

The Office Action stated that the level of ordinary skill in the art as demonstrated by Shiraishi et al. and Meadows et al. clearly indicates that making an inner bag which is already disclosed as being resilient (by Shiraishi et al.)

sufficiently resilient to assist/perform the suck back function as explicitly taught by Meadows et al. would produce the desired results through routine experimentation. Applicants traverse this statement on several grounds that have been set out above. Use of only rejection references can never resolve by themselves the level of ordinary skill in the art – instead, all of the prior art of record must be considered, analyzed, etc., in making the mandatory resolutions. Furthermore, Shiraishi et al. and Meadows et al. are inventors – their patents cannot “demonstrate” the ordinary skill in the art. The courts have held that inventors are not ones ordinarily skilled in the art. The Examiner still has not made one of the mandatory resolutions (with supporting analysis and supporting facts) in the record.

The Office Action stated, in reference to Claim 2, see Shiraishi et al. [0067]. The independent claim is not obvious to one ordinarily skilled in the art so this dependent claim is also not obvious to such person.

The Office Action stated, in reference to Claim 3, see Shiraishi et al., Fig. 1. This dependent claim is likewise also not obvious.

Withdrawal of this rejection is requested.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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Date

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